

REMARKS**I. Status of Claims**

Claims 1, 3-12, inclusive, and 15 are pending in this application. Claims 1, 3, 4, and 12 are amended in this response. Claims 2, 13, 14, and 16 are canceled without prejudice.

II. Response to the 35 USC §102 Rejection

Original claim 15 was not rejected as fully met by Commereuc et al. (6,743,958) hereinafter "Com."

The alkylation step of original claim 15 has been incorporated into original claim 1, and, thereby, into the claims that are dependent on claim 1, all the claims remaining in this application.

In order for a claimed invention to be anticipated under 35 USC §102, all of the elements of the claim must be found in one reference, *Scripps Clinic & Research Found v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir.1991).

Since Com does not even arguably disclose an alkylation step, as originally claimed by applicant, Com clearly does not anticipate any of the claims as amended and remaining in this application.

Accordingly, this rejection is respectfully traversed, and reconsideration and withdrawal of this rejection is requested.

III. Response to the 35 USC § 103 Rejection

The rejection of claim 15 as unpatentable over Com in view of Crossland et al. (5,157,196) is respectfully traversed.

The alkylation step of original claim 15 has been incorporated into original claim 1, now currently amended claim 1, hereinafter "claim 1." Claim 1 is the broadest independent claim pending in this application. Accordingly, this rejection will be discussed herein below in relation to this claim 1 since all the claims remaining in this application are dependent on that claim.

Claim 1 patentably distinguishes over the combination of Com in view of Crossland et al. in three aspects:

(1) Claim 1 requires the metathesis zone to be operated in such a manner as to produce a separate gasoline grade olefin product. This is supported by applicant's original specification page 9, lines 6-12, and original claim 16.

(2) Claim 1 requires that the product of the skeletal isomerization zone be recycled to applicant's distillation zone 5. This was presented in claim 1 as filed.

(3) Claim 1 requires the removal of a purge stream from at least one of the skeletal isomerization and metathesis zones, and the employment of same in an alkylation zone to form an alkylate of mixed isooctanes. This is supported by applicant's original specification page 8, lines 25-30; page 9, lines 15-17; and original claim 15.

None of these three aspects, much less the combination of all three, is suggested by Com or Crossland et al. when considered alone or in combination. The only way to ferret out any of these aspects from the teachings of Com and Crossland et al. is by way of an improper reliance on applicant's disclosure.

As to the first aspect above, Com does not disclose, suggest, nor imply that its metathesis zone could be or should be operated in such a manner that a "separate gasoline grade olefin product" is produced. Crossland et al. do not disclose a metathesis operation, and, therefore, cannot and do not supply this deficiency in Com. These references, taken alone or in combination, do not suggest the operation called for by this first aspect. Such a suggestion can only be found in applicant's disclosure, and it is improper under the law to rely on applicant's disclosure for the motivation required by the law to construe the prior art references in the manner done here by the Examiner.

Regarding the second aspect above, Com discloses only recycling from its skeletal isomerization zone 3 by way of line 6 to zone 1, see Com's drawings. Com does not disclose, suggest nor imply that its recycle 6 could be sent to its distillation zone 2. Crossland et al. do not disclose a skeletal isomerization zone in combination with a distillation zone, and, therefore, cannot and do not supply this deficiency in Com. These prior art references, alone or in combination, do not suggest the recycle step of this aspect. Such a suggestion can only be found in applicant's disclosure, and it is improper for the Examiner to rely on applicant's

disclosure for the motivation required under the law for the combination of the references relied upon for this rejection.

In respect of the third aspect above, Com does not disclose, suggest nor imply the use of an alkylation zone, and even expressly states in its specification, column 6, lines 19 and 20, that pentenes and hexenes are by-products of low value that are necessary to eliminate. This does not suggest to one skilled in the art to deliberately operate a skeletal isomerization and/or metathesis unit in a manner such that it forms a purge stream that is employable in an alkylation zone. Thus, Com does not suggest, and even teaches away from this aspect of the claimed invention. Crossland et al. do not disclose a skeletal isomerization step or a metathesis step, and, therefore, cannot and do not suggest forming from such steps a purge stream that is useful in an alkylation step. Accordingly, Crossland et al., when read without reliance on applicant's disclosure, do not suggest using the purge streams of claim 1 in an alkylation step, and, therefore, do not supply this deficiency in Com.

Com, Crossland et al., and the combination of Com and Crossland et al. do not suggest all three aspects in the same process. To accomplish this would require a reconstruction of this prior art in light of applicant's disclosure which is improper under the law.

Thus, the claimed combination of aspects above clearly is novel over and not suggested nor made obvious by the prior art references relied upon for this rejection. The legal test is obviousness of the invention as a whole, not of pieces when dissected out after considering applicant's disclosure, *Harpman v. Watson*, 124 USPQ 169.

The instant combination of references runs afoul of *Ex parte Lennox*, 144 USPQ 224, in that after studying the references themselves and the manner in which the Examiner proposes to combine them, there still is no suggestion found in the references themselves that they can be or should be combined to produce applicant's claimed result in the absence of an improper reliance on applicant's disclosure.

Notwithstanding a comprehensive and impressive application of the prior art to the claims, there are still significant gaps between applicant's claims and the disclosures of the prior art combination relied upon. To urge that it is obvious to do what applicant's claim, in spite of such gaps, is to assume applicant's invention rather than to find the teaching or reason in the art which one skilled in the art needs under the law, *In re Soli*, 137 USPQ 797.


Since the Examiner has not found nor provided the motivation for modifying the disparate processes of Com and Crossland et al. to meet the aspects of this invention discussed above, he has not carried the burden of establishing a prima facie case of obviousness.

Accordingly, reconsideration and withdrawal of this rejection is requested.

Wherefore, it is submitted that this application is now in condition for immediate allowance, and such action is hereby requested.

Respectfully submitted,

Robert S. Bridges, et al.

By 
Dennis M. Kozak
Reg. No. 28,318
Attorney for Applicants
Lyondell Chemical Company
3801 West Chester Pike
Newtown Square, PA 19073
Phone: (610) 359-2067
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